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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,750	08/03/2001	Jeffrey H. Diamond	0136.0003C	5953

7590 11/02/2004

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EXAMINER

A, PHI DIEU TRAN

ART UNIT PAPER NUMBER

3637

DATE MAILED: 11/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/920,750

Applicant(s)

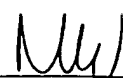
DIAMOND, JEFFREY H.

Examiner

Phi D A

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17, 19-24, 28-39, 51-57 and 59-63 is/are pending in the application.
- 4a) Of the above claim(s) 2, 4, 23, 24, 33 and 34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 5-17, 19-22, 28-32, 35-39, 51-57, 59-63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/19/04, 4/30/03
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Allowable Subject Matter

The indicated allowability of claims 20-21, 36-38 is withdrawn in view of the newly discovered reference(s) to Watanabe. Rejections based on the newly cited reference(s) follow.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 57 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 57 recites the broad recitation one or more handles, and the claim also recites a plurality of handles which is the narrower statement of the range/limitation.

Claim Objections

4. Claim 6 is objected to because of the following informalities: line 1 “ 1wherein” is improper. Should it be “ 1 wherein “?

Appropriate correction is required.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3, 5, 19, 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohayon (GB2208073) in view of Watanabe (JP2001152678).

Ohayon shows stabilized window structure (the structure to the mirror glass meets the claimed limitations to the window structure and thus read on the window structure) comprising a window frame (mirror housing), a shattered window pane (figure 1) disposed in the window frame and having an exterior surface and an exposed interior surface(exposed to part 64 of figure 6) circumscribed by the window frame, the interior surface being opposite the exterior surface, a layer of unifying material (the removable adhesive tape) adhesively bonded by itself directly (after being put in contact with the pane) to a substantial portion of at least one of the exterior surface or said interior surface, the layer of unifying material and the window pane bonded thereto forming an integral, rigid cohesive mass in which the shattered window pane is structurally united by the unifying material, the mass being removable from the window frame as

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one or more integral and unitary pieces, the window pane being non-planar (page 12 line 1), the frame is disposed in a vehicle, the layer of unifying material is disposed over substantially the entirety of the at least one of the exterior surface.

Ohayon does not disclose the adhesive tape being a sprayed on fluidic solidifiable layer.

Watanabe discloses spraying adhesive on a window pane in a fluidic form, solidifying the adhesive to bond itself to the window pane after being applied.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Ohayon's structure to show the adhesive tape being a sprayed on fluidic solidifiable layer because using sprayed on fluidic solidifiable layer would enable the easy quick covering bond of a variety of surface sizes without having to predetermine the needed tape dimension for the surfaces.

Ohayon as modified shows the layer solidifying after being applied to the pane surface, the layer of unifying material being capable of being sprayed onto the window pane in a fluidic form and solidifying on the window pane to adhesively bond itself to the window pane, the adhesive being disposed within the crack.

3. Claims 6-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohayon (GB2208073) in view of Watanabe (JP2001152678).

Ohayon as modified shows all the claimed limitations except for the polymeric material being polymeric foam including polyurethane, polyethylene, or polystyrene, the polymeric material being a polymeric film including polyvinyl, a latex, polyurethane, acrylate or cellophane, the material being cellulosic material.

Watanabe further discloses the adhesive being basic adhesive material with a foaming agent.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Ohayon's modified structure to show the adhesive being a polymeric material, the polymeric material being a polymeric foam including polyurethane, polyethylene, or polystyrene, the polymeric material being a polymeric film including polyvinyl, a latex, polyurethane, acrylate or cellophane, the material being cellulosic material because using adhesive with a foaming agent to bond glass together would enable the secure bonding of the glass with the adhesive as taught by Watanabe, and examiner takes Official Notice of the equivalence of adhesive disclosed by Watanabe and a polymeric material, the polymeric material being a polymeric foam including polyurethane, polyethylene, or polystyrene, the polymeric material being a polymeric film including polyvinyl, a latex, polyurethane, acrylate or cellophane, the material being cellulosic material, for their use in the glass surface bonding art and the selection of any of these known equivalents to bond the shattered pane would be within the level of ordinary skill in the art.

4. Claims 28-32, 35, 39, 51-55, 60-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohayon (GB2208073) in view of Watanabe (JP2001152678).

Ohayon as modified shows all the claimed limitations. The claimed method steps would have been the obvious method steps of stabilizing and removing the window pane from the frame with Ohayon's modified structures.

5. Claims 20-21, 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohayon (GB2208073).

Ohayon shows stabilized window structure (the structure to the mirror glass meets the claimed limitations to the window structure and thus read on the window structure) comprising a window frame (mirror housing), a shattered window pane (figure 1) disposed in the window frame and having an exterior surface and an interior surface exposed by the window frame, the interior surface being opposite the exterior surface, a layer of unifying material (the removable adhesive tape) adhesively bonded by itself directly (after being put in contact with the pane) to a substantial portion of at least one of the exterior surface or said interior surface, the layer of unifying material and the window pane bonded thereto forming an integral, rigid cohesive mass in which the shattered window pane is structurally united by the unifying material, the mass being removable from the window frame as one or more integral and unitary pieces.

Ohayon does not disclose at least one grasping member having a handle secured and bonded to the cohesive mass.

Ohayon further discloses a handle/grasping member(20) for moving a window pane by adhering the handle to the window pane.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Ohayon's structures to show at least one grasping member having a handle secured and bonded to the cohesive mass because the handle/grasping member would enable the easy removal of the shattered glass once broken from the frame without having the hand directly grab the cohesive mass and thus preventing potential broken glass cutting the hand.

Per claims 36, 38, Ohayon as modified shows all the claimed structural limitations. The claimed method steps would have been the obvious method steps of stabilizing and removing the window pane from the frame with Ohayon's modified structures.

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6. Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ohayon (GB2208073) in view of Watanabe (JP2001152678).

Ohayon as modified shows all the claimed limitations except for the unifying material being applied in fluidic form, the material solidify by curing to bond the glass to the adhesive.

Watanabe discloses applying adhesive on a window pane in a fluidic form, solidifying the adhesive to bond itself to the window pane after being applied.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Ohayon's structure to show the adhesive tape being a fluidic solidifiable layer because using fluidic solidifiable layer would enable the easy quick covering bond of a variety of surface sizes without having to predetermine the needed tape dimension for the surfaces.

Ohayon as modified shows all the claimed structural limitations. The claimed method steps would have been the obvious method steps of stabilizing and removing the window pane from the frame with Ohayon's modified structures.

7. Claims 56, 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohayon (GB2208073) in view of Watanabe.

Ohayon shows protected window pane, comprising a window pane (figure 1) having a perimeter mounted in a window frame, the window pane having an exposed exterior surface and an exposed interior surface (exposed to the part 64) circumscribed by the frame, a layer of adhesive (the tape) adhered to at least a substantial portion of the exterior surface to provide protection to the window pane, the layer and the window pane forming a protected window pane.

Ohayon does not disclose the layer being a polymeric foam, one or more handles secured to the protected window pane by adhesion of the one or more handles with the foam, the adhesion between the foam and the window pane and between said one or more handles and the foam is provided by the foam itself and is of sufficient strength to allow the window pane to be remove from the frame by manually pulling on said one ore more handles without detaching the foam from the window pane.

Ohayon further discloses a handle/grasping member(20) for moving a window pane by adhering the handle to the window pane.

Watanabe discloses applying a polymeric foam layer to a window pane to foam a protected window pane by adhesion of the foam to the window pane.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Ohayon's structures to show the layer being a polymeric foam, one or more handles secured to the protected window pane by adhesion of the one or more handles with the foam, the adhesion between the foam and the window pane and between said one or more handles and the foam is provided by the foam itself because handles would enable the easy removal of the shattered glass once broken from the frame without having the hand directly grab the cohesive mass and thus preventing potential broken glass cutting the hand, and having the polymeric foam layer would enable the easy quick covering bond of a variety of surface sizes without having to predetermine the needed tape dimension for the surfaces.

Ohayon as modified shows the adhesion between the foam and the window pane and between said one or more handles and the foam is provided by the foam itself and is of sufficient strength to allow the window pane to be remove from the frame by manually pulling on said one

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or more handles without detaching the foam from the window pane, the layer permanently adhered to the window pane and the one or more handles are permanently adhered to the layer by the adhesion provided by the foam.

8. Claim 57 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ohayon (GB2208073) in view of Watanabe.

Ohayon as modified shows all the claimed limitations except for the one or more handles including plurality of handles.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Ohayon's modified structure to show the one or more handles including a plurality of handles because it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art; *St. Regis Paper Co. v. Bemis Co.* 193 USPQ 8.

Response to Arguments

1. Applicant's arguments with respect to claims 1, 3, 5-22, 28-32, 35-39, 51-57, 59-62 have been considered but are moot in view of the new ground(s) of rejection.

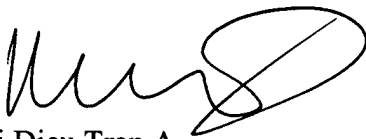
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phi D A whose telephone number is 703-306-9136. The examiner can normally be reached on Monday-Thursday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 703-308-2486. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Phi Dieu Tran A', with a large, stylized loop at the end.

Phi Dieu Tran A

10/28/04